

REMARKS

The Examiner is kindly requested to consider and initial next to each item of information listed in the Information Disclosure Statement filed January 14, 2010, and to return to the undersigned a fully-initialed copy of the Form PTO-1449.

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

As a preliminary matter, the finality of the rejection is improper. Section 706.07(a) of the MPEP states that a second or any subsequent actions on the merits should not be made final where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's claim amendments, nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR §1.97(c). Here, the Official Action sets forth a new ground of rejection based on newly applied references. The new ground of rejection was not necessitated by amendments to the claims, as none of the independent claims were amended, and Claim 5 was amended only to correct a minor informality. Nor is the new ground of rejection based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR §1.97(c) (e.g., after the filing of a first action on the merits but before the close of prosecution). Accordingly, the finality of the rejection is improper. That is, the current Official Action should be designated as a *non-final* rejection.

By this Amendment, independent Claim 1 is amended to incorporate the subject matter of allowable Claim 23, independent Claim 13 is amended to define a spring element, and Claim 23 is canceled without prejudice. Thus, Claims 1-22 are now pending in this application. Claims 1, 4 and 13 are the only independent claims. No new matter is added by the above amendments.

Applicants appreciate the Examiner's indication that Claims 21-23 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims. By this Amendment, independent Claim 1 is amended to incorporate the subject matter of allowable Claim 23. Thus, independent Claim 1, along with respective dependent Claims 2 and 3, are allowable.

The Official Action rejects independent Claims 1 and 13 under 35 U.S.C. §102(b) over Russian Application Publication No. 1188033 ("SU 033"); and rejects independent Claim 4 under 35 U.S.C. §103(a) over European Application Publication No. 1 369 616 to Gedenk in view of SU 033.

The rejection of independent Claim 1 is rendered moot by the amendment to Claim 1.

Independent Claim 4 is directed to an axlebox-spring-unit of a railway bogie comprising at least one hydraulic spring having a housing being required for a functionality of the hydraulic spring and an axlebox. At least a part of the axlebox forms at least a part of the housing, and a spring element of the hydraulic spring is directly connected to the part of the axlebox.

The Official Action, as best understood, takes the position that it would have been obvious to replace the hydraulic assembly (i.e., the piston 3, resilient member 4 and rod 5) in the axle-boxed suspension disclosed by SU 033 with Gedenk's hydraulic spring 2 to result in the Claim 4 axlebox-spring-unit.

Gedenk's hydraulic spring 2 includes an elastomeric element 8, and a cover 4 enclosing a fluid 6 for a functionality of the hydraulic spring 2 as shown in Fig. 1 of Gedenk. The Official Action says that the elastomeric element 8 corresponds to the claimed spring element. However, the elastomeric element 8 is directly connected to

an outer ring 10 of the hydraulic spring 2. The elastomeric element 8 is not directly connected to a part of a housing required for a functionality of the hydraulic spring 2. Further, SU 033's resilient member 4 is connected to a holder 13 of the hydraulic assembly as shown in Fig. 1 of SU 033. That is, SU 033's resilient member 4 does not directly contact the walls of the hydraulic cylinder 1. Moreover, even if the hydraulic assembly of SU 033 was replaced with Gedenk's hydraulic spring 2, the elastomeric element 8 of the hydraulic spring 2 would not directly contact the walls of SU 033's hydraulic cylinder 1. Instead, the elastomeric element 8 would directly contact the outer ring 10 of the hydraulic spring 2 as discussed above.

Accordingly, the combination of Gedenk and SU 033 fails to disclose, and would not have rendered obvious, an axlebox-spring-unit having the combination of features recited in independent Claim 4, including a spring element of the hydraulic spring directly connected to the part of the axlebox. Therefore, independent Claim 4 is patentable over the combination of Gedenk and SU 033 for at least this reason.

Independent Claim 13 is amended to recite that a spring element of the at least one hydraulic spring is *secured directly* to the axlebox to define together with the cup-shaped region a volume for receiving a hydraulic fluid.

As discussed above, SU 033 and Gedenk, alone or in combination, fails to disclose or suggest a spring element of a hydraulic spring that is secured directly to an axlebox. Thus, independent Claim 13 is patentable over the SU 033 and Gedenk for at least the reasons discussed above.

Dependent Claims 5-12 and 14-20 are patentable over the applied references at least by virtue of their dependence from patentable independent Claims 4 and 13, respectively. Thus, a detailed discussion of the additional distinguishing features recited in these dependent claims is not set forth at this time.

Withdrawal of the rejections is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

The Director is hereby authorized to charge any appropriate fees under 37 CFR §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

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